



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,513	11/29/2001	Peter J. Armbruster	IR105441	5018

23330 7590 08/01/2005

MOTOROLA, INC.
LAW DEPARTMENT
1303 E. ALGONQUIN ROAD
SCHAUMBURG, IL 60196

EXAMINER

DAGOSTA, STEPHEN M

ART UNIT	PAPER NUMBER
----------	--------------

2683

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/997,513

Applicant(s)

ARMBRUSTER ET AL.

Examiner

Stephen M. D'Agosta

Art Unit

2683

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 11 does NOT place the application in condition for allowance because: The primary examiner has objected to claim 25 but the applicant has not amended the independent claim with this limitation hence it continues to read on the prior art of record.

The primary examiner is not swayed by the applicant's argument(s), notably independent claim 1 is written in a broad fashion, eg. there is no detail as to where the "user processor" is actually located, therefore this is open to broad interpretation. As discussed in the Final Rejection, the prior art is correctly applied such that one skilled can broadly interpret the teachings to read on the claim:

"...1. The applicant argues that the prior art cited does not teach a personal HLR located in a processor of a user for a user to select services. The primary examiner disagrees since he broadly interprets the claim limitations as they pertain to the prior art of record. Sonti is put forth to teach a user having access to an HLR, as does Gentry. Niepel teaches a SIM card that stores directory numbers which are associated with different subscriber profiles (see abstract). Hence the user is, in effect, able to select services in his SIM (eg. processor) by changing directory numbers which broadly reads on the claim:

The primary examiner notes that the claim is not written in such detail that it is novel over the Sonti/Gentry/Niepel combination. Looking at claim 1.....(t)he primary examiner notes that there is no detail as to what a personal HLR is and/or contains. Hence Niepel's invention of a SIM card that stores MSISDN/IMSI numbers which are associated with different profiles reads on the claim since it is a "user processor" that allows a user to change between "profiles" when selecting different MSISDN/IMSI numbers. When a user chooses a certain MSISDN/IMSI number via "an interface", this effectively allows them to select different services which again reads on the claim. It is obvious to the examiner, and to one skilled in the art, that selecting the different MSISDN/IMSI numbers communicates the data to the service provider for them to provide that specific service profile.

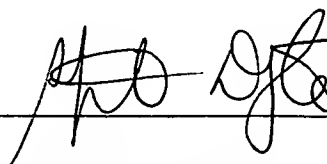
Hence, it appears that Sonti/Gentry/Niepel require the user to predefine profiles (and services) and indirectly select said services when a MSISDN/IMSI is chosen rather than just selecting a service. The primary examiner invites the applicant to amend their claims such that they are novel over Sonti/Gentry/Niepel."

While the claims are focused on updating an HLR, one skilled understands that a high-level view of these claims can be interpreted as a local database updating dating a remote database (which is well known in the art and therefore not novel). Specifically, the claims recite a user having a local database/file under their control which can be uploaded to a remote database/file (eg. the HLR). The examiner performed a quick search and found several pieces of art that read on this generic database update/synchronization procedure, see:

1. Boothby et al. US 6,212,529 - Synchronization of databases using filters
2. Klein et al. US 6,804,672 - Method and mechanism for dependency tracking
3. Lemke US 6,748,403 - Method and apparatus for perserving changes to data
4. Multer et al. US 6,671,757 - Data transfer and synchronization

The primary examiner believes that a more favorable outcome would occur if the applicant were to amend claim 1 with claim 25 (and/or if the applicant were to provide significantly more detail regarding the location of the user processor, such that the claim could not be broadly interpreted).

A Notice of Appeal/Appeal Brief will most likely cause the examiner to re-write the action as Non-Final and include some of the above referenced art. Hence, he believes the best path for prosecution is Amendment adding in the objected-to material and/or more definition regarding the location of the processor and it's connection to the network.


STEPHEN D'AGOSTA
PRIMARY EXAMINER
7-21-05